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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,669	11/25/2003	Larry M. Cirjak	BP 7339-06	5945
4249	7590	03/09/2006	EXAMINER	
CAROL WILSON BP AMERICA INC. MAIL CODE 5 EAST 4101 WINFIELD ROAD WARRENVILLE, IL 60555			CARR, DEBORAH D	
			ART UNIT	PAPER NUMBER
			1621	
DATE MAILED: 03/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/721,669	CIRJAK ET AL.	
	Examiner	Art Unit	
	Deborah D. Carr	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16 and 18-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 and 18-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 28 recites the limitation "concentration of oxygen in the combined gaseous feeds is between 8 to 25 volume percent" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16, 18-28 rejected under 35 U.S.C. 103(a) as being unpatentable over Sennewald (GB – 1,266,623) and Sennewald (GB – 1,266,624) in view of Provine (US Pat. 5,688,993) optionally in view of Calcagno (US Pat. 3,714,237).

The primary references GB'623 & GB'624 teach the claimed process except oxygen is not introduced in a further inlet or the concentration of oxygen in the combined gaseous feeds entering the reactor. Whether oxygen is mixed with the other reactants prior to introduction into the reaction zone or added separately appears to be merely an arbitrary choice.

However, it would be readily apparent to one of ordinary skill in the art the ultimately desired results of all reactants being present in the reactor would be achieved regardless of whether oxygen is fed separately from or together with the ethylene and acetic acid reactants. One would still expect all reactants to undergo the same reaction whether the mixing occurs before the reaction zone or within the reaction zone. Moreover, it was apparently recognized in the very similar process of US'237, note lines 4-9 of col. 2. While US'237 is not exactly the same process, it is clear from the reference that it was recognized in the vinyl acetate art that oxygen can be supplied separately from the other feeds. No unexpected result is seen for supplying the oxygen separately at the same concentration as suggested in the prior art and applicants do not present any persuasive evidence that their process would afford any expected result when operating at the prior art oxygen feed rates. The claims required that the amount of oxygen used to exceed the flammable limits of the feed mixture and read on the amount exemplified in US'993 note col. 6, lines 51-52 recites

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that oxygen is present in the range of 1-20%, preferably 5-10% which is apparently within the claimed range.

The examiner recognizes that combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion can only establish obviousness, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, US'237 clearly shows that in the vinyl acetate manufacturing art it is known that it is unnecessary to combine the feeds prior to entering the reaction zone in very similar processes. US'237 merely states the obvious.

While one can point out distinctions between the respective processes such as vapor phase versus liquid phase, there are a variety of similarities. They both use the same reactants; they both afford the same products they both involve fluidized catalyst systems (one catalyst supported on an inert carrier that is fluidized the other having the catalyst suspended in a fluid, both processes use palladium catalyst, etc.).

It is considered that the respective processes are sufficiently similar that one skilled in the art would be familiar with all three and one would expect features used in one (such as a separate oxygen feed and oxygen range) could be used in the other.


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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D. Carr whose telephone number is 571-272-0637.

The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DEBORAH D. CARR
PRIMARY EXAMINER

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